

## **REMARKS**

In the Office Action mailed May 16, 2005, the Examiner rejected claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over *Contos et al.* (U.S. Patent No. 6,529,784) in view of *Lee et al.* (International Application No. WO 97/46932) and *Hanson et al.* (U.S. Patent No. 5,517,434).

Based on the following arguments, Applicants respectfully traverse the Examiner's rejection of claims 1-27 under 35 U.S.C. § 103(a).

### I. The Rejection Under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." M.P.E.P. § 2143. Applicants respectfully traverse the rejection of claims 1-27 under 35 U.S.C. § 103(a) as unpatentable because the Examiner has failed to establish a *prima facie* case of obviousness.

In rejecting independent claims 1, 12, and 26, the Examiner asserts the same arguments presented in the Office Action mailed September 13, 2004 with respect to the alleged teachings of *Contos et al.* and *Lee et al.* The Examiner, however, admits that these references do not teach the recitations of independent claims 1, 12, and 26

being “installed on a ‘work machine.’” (OA at 4.) To satisfy this deficiency, the Examiner asserts it would have been obvious to combine *Cantos et al.* and *Lee et al.* in a work machine based on the teachings of *Hanson et al.* Applicants respectfully disagree with the Examiner’s position for the following reasons.

**a. *Hanson et al.* does not teach updating software installed on a work machine as asserted by the Examiner**

Citing to col. 17, lines 45-61, the Examiner asserts *Hanson et al.* discloses “updating software installed on a work machine.” (OA at 4.) Applicants disagree. *Hanson et al.* describes a portable data terminal (e.g., Fig. 1, element 10, Fig. 16, element 300) that may be removably connected to a vehicle data bus via a receptacle (e.g., Fig. 16, element 330). In certain embodiments, the data terminal is used by a vehicle operator to track items by scanning bar codes attached to the items. (*Hanson et al.*, 2:20-25.) *Hanson et al.* describes in column 17 a storage means 370, control means 380, and an EEPROM “containing downloading/uploading control programming and application programming in RAM storage of means 370 for controlling on board devices . . .” (*Hanson et al.*, 17:44-54.) Storage means 370, however, is contained within data terminal 300, which is not part of a work machine. Indeed, the portable nature of the data terminal disclosed by *Hanson et al.* teaches away from having the terminal, and its components, fixed to a particular location. (See e.g., *Hanson et al.* 2:7-30, 6:35-38, and 17:62 to 18:6.)

Claim 1 recites, among other things,

[a] system for updating software installed on a work machine, *the work machine having at least one non-volatile memory for storing the software . . .*

a remote communications system operably connected to said remote processor, said remote communications system

receiving said available updates from said remote processor and *relaying said available updates to said work machine for storage in said non-volatile memory.*

(Emphasis added.) Claim 12 recites in part,

[a] method for remotely updating software installed on a work machine, *the work machine having at least one non-volatile memory for storing the software . . .*

*relaying said available update from said remote data storage system to said work machine; and*

*installing said available update in said non-volatile memory.*

(Emphasis added.) And, claim 26 recites in part,

[a] system for updating software installed on a work machine, the work machine having at least one non-volatile memory for storing the software . . .

*means for remotely communicating with the work machine to relay said available updates to the work machine for storage in said non-volatile memory.*

(Emphasis added.) Accordingly, claims 1, 12, and 26 require, among other things, that the update(s) be stored or installed in the non-volatile memory of a work machine. In contrast, *Hanson et al.* discloses a portable data terminal that includes software. The data terminal is not a work machine, nor is it part of the work machine. Instead, the data terminal is a removable device that is connected to vehicle via a receptacle. Further, although *Hanson et al.* states data terminal 300 includes an EPROM "containing downloading/updating control programming," the reference falls short of describing a work machine including non-volatile memory that stores updates.

Because, as admitted by the Examiner, *Cantos et al.* and *Lee et al.* do not disclose installing or storing software updates in a non-volatile memory of a work machine, and as noted above, *Hanson et al.* does not make up for these deficiencies,

the Examiner has not established a *prima facie* case of obviousness. As such, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 12, and 26 under 35 U.S.C. § 103(a) and allow the claims.

Claims 2-11 depend from claim 1. Claims 12-25 and 27 depend from claims 12 and 26, respectively. As explained, *Cantos et al.*, *Lee et al.*, and *Hanson et al.*, alone or in any combination, fail to teach or suggest the recitations of claims 1, 12, and 26. Accordingly, these references also fail to teach or suggest the recitations of claims 2-11, 13-25, and 27 for at least the same reasons set forth in connection with claims 1, 12, and 26. As such, Applicants respectfully request that the Examiner withdraw the rejection of these claims under 35 U.S.C. 103(a) and allow the claims.

**b. There is no motivation to combine *Hanson et al.* With *Cantos et al.* and *Lee et al.*, as asserted by the Examiner**

Furthermore, the Examiner's allegations do not establish that a skilled artisan would have modified *Cantos et al.*, *Lee et al.*, and *Hanson et al.* to include the features of claims 1-27. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). The desire to combine or modify references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be "clear and particular." *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Cantos et al.*, *Lee et al.*, and *Hanson et al.*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify the references in a manner resulting in Applicants’ claimed combination. The Examiner’s assertion that it would have been obvious to combine *Cantos et al.*, *Lee et al.*, and *Hanson et al.* because “vehicle controllers/computers are known in the art and maintaining, updating the controllers enhances the value of such equipment” (OA at 4.) does not establish a motivation or suggestion for modifying the cited art. M.P.E.P. § 2143.01 makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that *Hanson et al.*, *Cantos et al.*, or *Lee et al.* suggest the desirability of a modification resulting the combination of elements recited in claims 1-27.

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The Court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”

*Id.* In this case, the Examiner merely alleged that *Hanson et al.* discloses certain elements without showing reasons why a skilled artisan would select or modify those elements in the manner claimed and without showing that the claimed invention as a whole would have been obvious. Discussing the particulars of *Hanson et al.* to assert a motivation to combine the reference with *Cantos et al.* and *Lee et al.* does not suffice to establish a *prima facie* conclusion of obviousness (e.g., OA at 4).

Indeed, the reasons for combining the cited art set forth by the Examiner do not address the asserted combination. Instead, the Examiner concentrates strictly on the disclosure of *Hanson et al.* to suggest the need for updating controller/computers on a work machine. Nowhere does the Examiner show where *Cantos et al.* and *Lee et al.* discloses a suggestion that would have motivated one of ordinary skill in the art to apply a portable data terminal system that may be removably connected to a vehicle, as disclosed by *Hanson et al.*, to the computer network systems described by *Cantos et al.* and *Lee et al.*. Nor does the Examiner offer a reason why the general knowledge in the art at the time of Applicants' invention would have motivated such a combination. Instead, the Examiner's offers motivational reasons that are confined to *Hanson et al.* alone, relying on an unsupported conclusion that maintaining and updating vehicle controllers "enhances the value of such equipment." (OA at 4.) Accordingly, the Examiner has not shown why one of ordinary skill in the art would have been motivated to combine *Hanson et al.* with *Cantos et al.* and *Lee et al.*.

Accordingly, the Examiner's conclusions set forth in the Office Action were not reached based on facts gleaned from the cited references. Instead, Applicants submit

the disclosure of the present application was improperly used to reconstruct the cited art to improperly reject claims 1-27 under 35 U.S.C. § 103(a).

For at least these additional reasons, the Examiner has not established a *prima facie* case of obviousness, and Applicants request that the rejection of claims 1-27 under 35 U.S.C. § 103(a) be withdrawn, and the claims allowed.

II. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of claims 1-27.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

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